

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 2, 3, 5 and 19, 20, 23 and 24 are rejected under 35 USC 102(b) over the U.S. patent to Godfrey.

Claim 8 is rejected under 35 USC 102(b) or 103(a) over the U.S. patent to Godfrey.

Claim 18 is rejected under 35 USC 102(b) as anticipated by the patent to Godfrey or as obvious over the patent to Godfrey in view of the patent to Odendahl.

Claims 16 and 17 are rejected under 35 USC 102(b) as anticipated or under 35 USC 103(a) as obvious over the U.S. patent to Wagner.

Claim 22 is rejected under 35 USC 103(a) as being obvious over the U.S. patent to Godfrey.

Also, the claims are rejected under 35 USC 112, second paragraph.

After carefully considering the Examiner's grounds for rejection of the claims, applicants amended Claims 16, 23, 24 and some dependent claims to more

clearly define the present invention, to make them definite, and to distinguish from the prior art.

Also, new Claims 25 and 26 have been added.

It is respectfully submitted that the new features of Claim 16 are disclosed on page 8, lines 16-18 and can be seen in Figure 2 of the application.

The new features of Claim 23 are disclosed in the previously presented Claim 16, on page 8, lines 16-18 of the specification, and can be seen in Figure 2 of the application.

The new features of Claim 24 are disclosed on page 6, lines 16-18 and can be seen in Figure 2 of the application.

The new features of new Claim 25 are disclosed in the previously presented Claim 24, on page 7, lines 9-11, on page 8, lines 3-8 and 16-18 of the specification, and can be seen in Figure 2 of the application.

Finally, the features of Claim 26 are disclosed in the previously presented Claims 16 and 24, on page 7, lines 9-11, on page 8, lines 5-6 and 16-18, on page 9, line 23 to page 10, line 7 of the specification, and can be seen in Figure 2 of the application.

Turning now to the prior art applied by the Examiner, it is respectfully submitted that the U.S. patent to Godfrey discloses a handheld power saw (10) having a housing (12) and a guide assembly with two lateral bracing means (88, 90). The bracing means (88, 90) are located in the housing (12) to guide an oscillating motion of a lifting rod (78) to which a saw blade (B) can be connected (the patent to Godfrey, column 3, lines 27 to 28, Fig. 1 and 5). To connect the saw blade (B) to the lifting rod (78), the handheld power saw (10) comprises a clamp blade (94) which can be attached to the lifting rod (78) for clamping the saw blade (F3) in various positions thereto (the patent to Godfrey, column 3, lines 37 to 38). The clamp blade (94) is channel-shaped for fitting over an end of the lifting rod (78) which protrudes out of a housing (12) of the handheld power saw (10) so that the clamp blade (94) is located outside the housing (12). The clamp blade (94) comprises a small hardened locating pin (128) and a screw hole (130) for insertion of a screw (132) to connect the saw blade (78) to the lifting rod (78) via the clamp blade (94) for preventing the saw blade (B) from pulling out of the camp blade (94) during sawing operation (the patent to Godfrey, column 4, lines 26 to 39).

The U.S. patent to Godfrey does not disclose a clamping sleeve into which upon assembly a T-shaped extension of a retaining region of the saw blade (B) is inserted along an insertion direction of the saw blade (B). Moreover, the U.S. patent to Godfrey does not disclose the feature that the bracing means (88, 90) are located along the insertion direction of the saw blade (B) in front of a clamping sleeve. Even if the clamp blade (94) is interpreted as a clamping sleeve, the U.S. patent to Godfrey does not disclose the above feature. The bracing means (88, 90) of the patent to Godfrey are located along a direction pointing from the saw blade (B) to the housing (12) - which can

be seen as the insertion direction - behind the clamp blade (94). Furthermore, the patent to Godfrey lacks the features of a bolt, a pressure roller and a pressure bolt for guiding the saw blade (B). Therefore, the new features of the present invention defined in claims 16 and 23 to 26 are not disclosed in the U.S. patent to Godfrey.

The U.S. patent to Wagner discloses a handheld power saw having a housing (2) and a guide assembly with two lateral bracing means (44, 45). The bracing means (44, 45) are located in the housing (2) to guide an oscillating motion of a lifting rod (23) to which a saw blade (7) can be connected (prior art document Wagner, column 3, lines 33 to 36, Fig. 1). To connect the saw blade (7) to the lifting rod (23), the handheld power saw comprises coupling means (48, 53, 58) which can be attached to the lifting rod (23) for clamping the saw blade (7). The lateral bracing means (44, 45) are located along an insertion direction of the saw blade (7) behind the coupling means (48, 53, 58).

The U.S. patent to Wagner does not disclose bracing means (44, 45) which are located along an insertion direction of the saw blade (7) in front of a clamping sleeve of the coupling means (48, 53, 58). Moreover, the patent to Wagner lacks the features of a contact face of the bracing means (48, 53, 58) which abuts on a guide region of the saw blade (7), and of the saw blade (7) being directly guided via the bracing means (44, 45). Therefore, the new features of the present invention defined in claims 16 and 23 to 26 are not disclosed in the U.S. patent to Wagner.

The U.S. patent to Odendahl et al. discloses a handheld power saw (10) having a housing (2) and a pressure roller (128) for directly guiding a saw blade (122) of

the handheld power saw (10). The patent to Odendahl et al. lacks the features of a clamping sleeve and of at least one bracing means located along an insertion direction of the saw blade (122) in front of the clamping sleeve (60). Therefore, the new features of the present invention defined in claims 16 and 23 to 26 are not disclosed in the U.S. patent to Odendahl et al.

As for the anticipation rejection of the claims applied by the Examiner, it is respectfully submitted that, as explained hereinabove, the new features of the present invention as defined in the above analyzed claims are simply not disclosed in the references. In connection with this, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the above analyzed references did not disclose each and every element of the present invention as defined in the claims.

Therefore, the anticipation rejection applied against the original claims should be considered as not tenable and should be withdrawn.

As for the obviousness rejection applied by the Examiner, it is respectfully submitted that a person skilled in the art could not extract any hints from the patents to

Godfrey, Wagner or Odendahl et al. at the time the invention was made which would lead him to the new features defined in the independent claims 16 and 23 to 26. None of the patents to Godfrey, Wagner or Odendahl et al. discloses at least one bracing means located along an insertion direction of a saw blade in front of a clamping sleeve of a coupling means connecting the saw blade to a lifting rod.

In order to arrive at the present invention from the references taken singly or in combination with one another, it would not be sufficient to use the teachings of the references singly or in combination, but instead it would be necessary to fundamentally modify the solutions proposed in the references by including into them the new features of the present invention. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Therefore the obviousness rejection applied by the Examiner against the original claims should also be considered as not tenable with respect to the amended claims and should be withdrawn as well.


Claims 16 and 23-26 should be considered as patentably distinguishing over the art and should be allowed.

As for the retaining dependent claims, these claims share the allowable features of the independent claims from which they depend and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicant  
Reg. No. 27233